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NIXON & VANDERHYE, PC
901 NORTH GLEBE ROAD, 11TH FLOOR
ARLINGTON, VA 22203

EXAMINER
BARQADLE, YASIN M

ART UNIT	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	09/892,747	NOMURA ET AL.
	Examiner	Art Unit	
	YASIN M. BARQADLE	2456	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>26 February 2009</u>.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>1,2,6-9,11-13,15-17 and 20-33</u> is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) <u>1-2, 6-9, 11-13, 15-17, and 20-33</u> is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a) ☐ All b) ☐ Some * c) ☐ None of:
        1. ☐ Certified copies of the priority documents have been received.
        2. ☐ Certified copies of the priority documents have been received in Application No. _____.
        3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)
1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

Continued Examination Under 37 CFR 1.114

1.   A request for continued examination under 37 CFR 1.114, including the
fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection.
Since this application is eligible for continued examination under 37 CFR
1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality
of the previous Office action has been withdrawn pursuant to 37 CFR 1.114.
Applicant's submission filed on February 26, 2009 has been entered.

Response to Amendment

2.   The amendment filed on February 26, 2009 has been fully considered
but are not persuasive.

- Claims 1-2, 6-9, 11-13, 15-17, and 20-33 are presented for
  examination.

Response to Arguments

In essence the Applicant argues system, "Neither Oki nor Nakagawa discloses
or suggests the concept of a "program list which prioritizes programs that are
likely to be operable in an operating environment of the user system" as
variously set forth in each of the independent claims." page 12.

The Examiner notes that Oki teaches providing program list that are likely to
be operable in an operating environment of the user system. The
circumstance checking unit compares the circumstance information received

from the circumstance information informing unit with that of the target
software to check whether or not they are compatible, and informs the
installing unit of the check result thus obtained. The installing unit decides
whether or not the target software is to be distributed and if so, it determines a
software distributing method, in response to the check result." (Oki, col. 2,
lines 37-44; col. 8, lines 36-65 and col. 12, lines 24-32). In Oki the
software is provided to user terminal based circumstance information that
indicates type of hardware and software available in the user system (col.
5, lines 40-44 and col. 6, lines 32-43. See also col. 2, lines 37-44; col. 8,
lines 36-65 and col. 12, lines 24-32). However, as indicated in the office
action. Oki does not show where the likely operable programs are
prioritized in a list.

In Oki the user select keywords corresponding target software, and based on
the selection a list of programs retrieved from plural software are provided "The
selecting unit enables each user to select one or more keywords, which
correspond to the target software, from those displayed by the keyword display
unit, and inform the installing unit of them. The installing unit retrieves the
target software from plural software, using the one or more keywords received.
 The circumstance information informing unit obtains circumstance
information relating to software operation circumstances in the terminal
equipment and informs the distributing center of them. The circumstance
checking unit compares the circumstance information received from the
circumstance information informing unit with that of the target software to
check whether or not they are compatible, and informs the installing unit of
the check result thus obtained. The installing unit decides whether or not the
target software is to be distributed and if so, it determines a software
distributing method, in response to the check result." Col. 2, lines 45-27).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-2, 6-9, 11-13, 15-17 and 20-23, 25 and 29-32 are rejected under 35

U.S.C. 103(a) as being unpatentable over Oki (U.S. Patent Number **5,859,969,**

hereinafter "Oki") in view of Nakagawa et al USPN. (5835911)**,** hereinafter

"Nakagawa"). Oki discloses a remote installation system and method. Oki

shows:

In referring to claim 1 and 8, Oki teaches a program supply method for

transmitting a program from a server via network to a user system to which

one or more expansion units may be attached (abstract and system in fig. 2),

the method comprising:

Requesting the server to provide a list of programs which can be supplied by

the server ((col. 12, lines 24-33. see fig. 21, software group 35 and key tables

32 and 33 on host computer (server) 21);

- Transmitting an operating environment of the user system from the user

  system via the network to the server "A circumstance file 31, including

  circumstances under which tools such as the hardware and software of

  the terminal 23 are operated, is created in the terminal 23 and sent to

  the host computer 21 when the user gains access to the host computer

21. The host computer 21 holds the received circumstance file 31 for every user and uses it to check whether or not the software selected by the user can be operated in the terminal 23." (col. 5, lines 40-44 and col. 6, lines 32-43)

- Providing, from the server to the user system, a program list that are likely to be operable in an operating environment of the user system Transmitting an operating environment of the user system from the user system via the network to the server before supplying the program: "The contents of each software in the software group 35 are stored, having been previously related to some of the keywords. In FIG. 10, for example, a software A has three keywords such as "game", "image" and "DOS", while software B four keywords such as "image", "tool", "WIN", and "game". When the user A selects two keywords such as "image" and "game", therefore, a list including these two items of software is sent from the host computer 21 and displayed on the screen of the display 24." (col. 12, lines 24-33. see fig. 21, software group 35 and key tables 32 and 33 on host computer (server) 21);
"The circumstance information informing unit obtains circumstance information relating to software operation circumstances in the terminal equipment and informs the distributing center of them."
- After a program is selected from the list, transmitting the program form the server to the user system: "The circumstance checking unit compares the circumstance information received from the circumstance information informing unit with that of the target software to check whether or not they are compatible, and informs the installing unit of the check result thus obtained. The installing unit decides whether or not the target software is to be distributed and if so, it determines a software distributing method, in response to the check result." (Oki, col. 2, lines 37-44; col. 8, lines 36-65 and col. 12, lines 24-32).
- Executing the program on the user system after the program is supplied from the server and installed on the user system: The purpose of the

system of Oki is to download new software to be executed on the client.
Executing the software is inherently implied in the system of Oki

Although Oki shows substantial features of the claimed invention, he does
not explicitly show receiving confirmation at a server of proper operation of
the program in operating environment of a user system (each expansion
unit is hardware that includes the operating environment of user computer
system).

Nonetheless, this feature is well known in the art and would have been an
obvious modification of the system disclosed by Oki, as evidenced by
Nakagawa USPN. (5835911).

In analogous art, Nakagawa disclose "If the third process unit CP receives a
message from vendors V1, V2, . . . and stores or installs in the user
computer 11 new software, newly served software, or updated software
received from vendor Vk, then the third process unit CP monitors the result
of these processes and sends to the fourth process unit SP of vendors V1,
V2, . . . over the network 12 a process result confirmation message
informing whether the process has terminated normally or abnormally. As a
result, the vendor can recognize a process result in the user computer 11"
(col. 28, lines 38-51).

Giving the teaching of Nakagawa, a person of ordinary skill in the art would
have readily recognized the desirability and the advantage of modifying Oki
by employing the system of Nakagawa because it enables the
provider/vendor of the software to recognize the process result in the user
computer including expansion units so that the vendor can demand
payment for the software if it working properly or fix the bugs in the
software if is not working properly.

Nakagawa further teaches requesting payment for a program "Every user is
sent the object software as shareware on the response of the new purchase

request, and the and the above described fund is demanded of the user to pay after the user's satisfaction of the software." (User satisfaction must be received before demanding funds by the vendor server col. 59, lines 35-50).

Although Oki shows substantial features of the claimed invention, including providing list of programs operable on the client system, Oki does not explicitly show where the programs are prioritized in the list.

Nonetheless, the feature of prioritizing programs in a list is well known in the art and would have been an obvious modification of the system disclosed by Oki. One ordinary skill in the art at the of the invention would include the program list provided by host computer of Oki a mechanism to prioritize the programs in that list in such a way that most likely programs of interest are to the user are listed first. In this way it would be easier for the user to select the most appropriate programs first.

In referring to claim 2,

- Displaying the result of the judgment as to whether the program is operable or not in the operating environment of the user system:

    "The installing menu display unit displays plural methods of installing the target software." (Oki, col. 3, lines 45-46)

In referring to claim 9,

- Transmitting an order for the program from the user system via the network to the server when the program is judged to be operable:

    Oki, Fig. 4 shows selecting a program S12, checking if the program is operable at S14, Fig. 5 shows transmitting the selected program at S18

In referring to claim 6 and 11,

- Storing the result of judgment as data of the user system in the server
  when the program is judged to be inoperable:
  Storing the result of a judgment made in a server is inherently implied in
  a server that conducts said judgment

In referring to claim 7,

- Expanding functions of the user system when a program supplied from
  the server via the network to the user system is installed:
  Expanding functions of a user system by installing a program is
  inherently implied in a system in which a program is installed in a user
  system

In referring to claim 12,

- Said user system includes operating environment judging means for
  judging an operating environment of the user system, and before having a
  program supplied, transmits the judged operating environment via the
  network to the server:
  Oki, col.2, lines 33-36 (see full quote above)

- said server includes a list generating means for generating a program list
  that are likely to be operable in an operating environment of the user
  system and transmitting the program list via the network to the user
  "The contents of each software in the software group 35 are stored, having
  been previously related to some of the keywords. In FIG. 10, for example, a
  software A has three keywords such as "game", "image" and "DOS", while
  software B four keywords such as "image", "tool", "WIN", and "game". When
  the user A selects two keywords such as "image" and "game", therefore, a
  list including these two items of software is sent from the host computer 21
  and displayed on the screen of the display 24." (col. 12, lines 24-33. see fig.

21, software group 35 and key tables 32 and 33 on host computer (server)
21);

- Said user system is operable to execute the program on the user system
  after the program is supplied from the server and installed on the user
  system to thereby confirm operation of the program:

    The purpose of the system of Oki is to download new software to be
  executed on the client. Executing the software is inherently implied in the
  system of Oki

  As to receiving confirmation information and requesting payment for a
  program after its proper operation in user computer system (expansion units
  included) see the rejection above in claim 1 and 8.

  Although Oki shows substantial features of the claimed invention, including
  providing list of programs operable on the client system, Oki does not
  explicitly show where the programs are prioritized in the list.
  Nonetheless, the feature of prioritizing programs in a list is well known in
  the art and would have been an obvious modification of the system
  disclosed by Oki. One ordinary skill in the art at the of the invention would
  include the program list provided by host computer of Oki a mechanism to
  prioritize the programs in that list in such a way that most likely programs
  of interest are listed first to the user. In this way it would be easier for the
  user to select the most appropriate programs first.

In referring to claim 13,
- Operation input means to be operated by a user, said user system is activated in
  response to operation on the operation input means:

    `When the user inquires of the host computer 21 for the keyword lists through the
    terminal 23, the host computer 21 transmits' the first and second key tables 32 and 33
    successively and displays keywords included in them on the display 24 of his terminal

23. The user selects the displayed keywords which corresponds to the target software and informs the host computer 21 of his selection." (Oki, col. 5, lines 14-20)

- Display means for displaying data; displaying the result of judgment given by the operation judging means of the server on the display means:

  Oki, *col. 3, lines 45-46* (see full quote above)

- The user system transmits the operating environment judged by the operation environment judging means via the network to the server:

  Oki, Fig. 3 shows judging the operation environment at steps S1 and S2, and then _ transmitting them at step S3

In referring to claim 15,

- Said server further includes storing means for storing data of the user system: Receiving user data and running a script on said user data (Oki, Fig.4, S14 and 40) inherently implies a storing means to store said user data

In referring to claim 16,

- Said user system expands its functions when a program supplied via the network from the server is installed.

Expanding functions of a user system by installing a program is inherently implied in a system in which a program is installed in a user system.

In referring to claim 17,

- Said user system is any of a personal computer, a portable terminal, and a complex digital image forming apparatus:

  Oki, Fig. 2 shows the user system is a portable terminal

In referring to claim 20,

- Said server stores the result of judgment by the operation judging means
  when the program is judged to be inoperable:
  Storing the result of a judgment made in a server is inherently implied in a
  server that conducts said judgment

In referring to claim 21-23, 25 and 29-32, Oki shows substantial features of the
invention as discussed in claims 1 and 8 above. Oki further teaches:

- Server-side communication means for transmitting data to and receiving
  data from the user system via the network; operation judging means for
  judging whether a program can be operated or not in the operating
  environment of the user system received via the server-side communication
  means:
  Oki, col. 2, lines 37-44 and col. 8, lines 36-65 (see full quote above)

- Said user system is operable to execute the program on the user system
  after the program is supplied from the server and installed on the user
  system to thereby confirm operation of the program: The purpose of the
  system of Oh is to download new software to be executed on the client.
  Executing the software is inherently implied in the system of Oki (See col.
  8, lines 36-65)

Although Oki shows substantial features of the claimed invention, he does
not explicitly show transmitting a notification of operation confirmation to a
server.

Nonetheless, this feature is well known in the art and would have been an
obvious modification of the system disclosed by Oki, as evidenced by
Nakagawa USPN. (5835911).

In analogous art, Nakagawa disclose "If the third process unit CP receives a
message from vendors V1, V2, . . . and stores or installs in the user
computer 11 new software, newly served software, or updated software
received from vendor Vk, then the third process unit CP monitors the result
of these processes and sends to the fourth process unit SP of vendors V1,

V2, . . . over the network 12 a process result confirmation message informing whether the process has terminated normally or abnormally."

Giving the teaching of Nakagawa, a person of ordinary skill in the art would have readily recognized the desirability and the advantage of modifying Oki by employing the system of Nakagawa because it enables the provider/vendor of the software to recognize the process result in the user computer so that the vendor can demand payment for the software if it working properly or fix the bugs in the software if is not working properly.

As to receiving confirmation information and requesting payment for a program after its proper operation in user computer system (expansion units included) see the rejection above in claim 1 and 8.

Although Oki shows substantial features of the claimed invention, including providing list of programs operable on the client system, Oki does not explicitly show where the programs are prioritized in the list.

Nonetheless, the feature of prioritizing programs in a list is well known in the art and would have been an obvious modification of the system disclosed by Oki. One ordinary skill in the art at the of the invention would include the program list provided by host computer of Oki a mechanism to prioritize the programs in that list in such a way that most likely programs of interest are to the user are listed first. In this way it would be easier for the user to select the most appropriate programs first.

In referring to claim 24,

- user-side transmitting means for transmitting an operating environment of the user system from the user system via the network to the server "A circumstance file 31, including circumstances under which tools such as the hardware and software of the terminal 23 are operated, is created in the terminal 23 and sent to the host computer 21 when the user gains

    access to the host computer 21. The host computer 21 holds the received
    circumstance file 31 for every user and uses it to check whether or not
    the software selected by the user can be operated in the terminal 23."
    (col. 5, lines 40-44 and col. 6, lines 32-43)

-
- User-side operation judging means for executing the received program,
  thereby confirming proper operation of the program; upon the user-side
  operation judging means executing the received program, (*Oki fig. 5 and Oki*,
  col. *2*, lines 37-44)

As per claims 23 and 33, although Oki shows substantial features of the
claimed invention, he does not explicitly show transmitting a notification of
operation confirmation to a server.

    Although Oki shows substantial features of the claimed invention, he does
    not explicitly show transmitting a notification of operation confirmation to a
    server.

    Nonetheless, this feature is well known in the art and would have been an
    obvious modification of the system disclosed by Oki, as evidenced by
    Nakagawa USPN. (5835911).

    In analogous art, Nakagawa disclose "If the third process unit CP receives a
    message from vendors V1, V2, . . . and stores or installs in the user
    computer 11 new software, newly served software, or updated software
    received from vendor Vk, then the third process unit CP monitors the result
    of these processes and sends to the fourth process unit SP of vendors V1,
    V2, . . . over the network 12 a process result confirmation message
    informing whether the process has terminated normally or abnormally."
    (Col. 28, lines 39-41).

    Giving the teaching of Nakagawa, a person of ordinary skill in the art would
    have readily recognized the desirability and the advantage of modifying Oki
    by employing the system of Nakagawa because it enables the

provider/vendor of the software to recognize the process result in the user computer so that the vendor can demand payment for the software if it working properly or fix the bugs in the software if is not working properly.

As to receiving confirmation information and requesting payment for a program after its proper operation in user computer system (expansion units included) see the rejection above in claim 1 and 8.

Although Oki shows substantial features of the claimed invention, including providing list of programs operable on the client system, Oki does not explicitly show where the programs are prioritized in the list.

Nonetheless, the feature of prioritizing programs in a list is well known in the art and would have been an obvious modification of the system disclosed by Oki. One ordinary skill in the art at the of the invention would include the program list provided by host computer of Oki a mechanism to prioritize the programs in that list in such a way that most likely programs of interest are to the user are listed first. In this way it would be easier for the user to select the most appropriate programs first.

In referring to claims 26,

- A computer-readable recording medium having a program for executing the program receiving method of claim 1 recorded thereon:

  A computer-readable recording medium having a program for executing the program is inherently implied in the computer system of Oki

In referring to claim 27,

- A computer-readable recording medium having a program for executing the program receiving method of claim 23 recorded thereon:

  A computer-readable recording medium having a program for executing the program is inherently implied in the computer system of Oki.

1.   Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over
Oki (U.S. Patent Number 5,859,969, hereinafter "Oki") in view of Nakagawa et
al USPN. (5835911), hereinafter "Nakagawa") and further in view of Applicant's
Admitted Prior Art (AAPA).

Regarding claim 33,

Although Oki and Nakagawa teach substantial features of the claimed
invention as shown in claims 1,8,25 and 29, they do not explicitly show
image formation apparatus with expansion units attached.

Nonetheless, this feature is well known in the art and would have been an
obvious modification of the system disclosed by Oki and Nakagawa as
evidenced by Applicant's Admitted Prior Art (AAPA) "Also, Japanese
Unexamined Patent Publication No. 68058/1989 (Tokukaisho 64-68058)
(published date: Mar. 14, 1989), discloses a facsimile apparatus whose
functions can be expanded. This facsimile apparatus obtains programs
for operating the expanded functions via communication means, and
carries out the programs. Thus, functions which were not provided in the
facsimile apparatus when it was purchased can be operated." (Page 2,
lines 1-6). Giving the teaching of AAPA, a person of ordinary skill in the
art would have readily recognized the desirability and the advantage of
modifying Oki and Nakagawa by employing the image forming apparatus
of AAPA in order to ensure and to judge whether a vendor supplied
program can be operated or not and to provide the most recent software
drivers that would guarantee the proper operation of the apparatus.

Although Oki shows substantial features of the claimed invention, including
providing list of programs operable on the image formation apparatus, Oki
does not explicitly show where the programs are prioritized in the list.

Nonetheless, the feature of prioritizing programs in a list is well known in the art and would have been an obvious modification of the system disclosed by Oki. One ordinary skill in the art at the of the invention would include the program list provided by host computer of Oki a mechanism to prioritize the programs in that list in such a way that most likely programs of interest are to the user are listed first. In this way it would be easier for the user to select the most appropriate programs first.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yasin Barqadle whose telephone number is 571-272-3947. The examiner can normally be reached on 9:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bunjob Jaroenchonwanit can be reached on 571-272-3913. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Yasin M Barqadle/
Primary Examiner, Art Unit 2456